

REMARKS

I. Telephone Interview with Examiner

Applicant's representatives thank Examiner Leroux for the courtesies extended in granting and conducting a telephone interview on April 2, 2009 between Examiner Leroux, the undersigned, and Ceyda A. Maisami, a student associate of the undersigned. The substance of the interview is summarized herein.

During the interview with Examiner Leroux, Applicant's representatives provided an overview of embodiments of the claimed data access and retrieval mechanism and identified the below cited elements in the claims, which they think distinguish the claimed methods, systems and computer-readable media from the cited references.

Although no agreement was reached on the claims' language, Examiner Leroux indicated that he understood the arguments presented by Applicant's representatives. Examiner Leroux suggested that the proposed limitations discussed during the interview be added to the claims, and requested that a written response be filed for his consideration.

II. Status and Disposition of the Claims

In the instant application, claims 1, 5, 7-17, 21, 23-33, 37, and 39-60, of which claims 1, 17 and 33 are independent, are pending and under consideration on the merits.

In the Office Action dated February 9, 2009¹, all of the pending claims were rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,405,206 to Kayahara (hereinafter "*Kayahara*") in view of U.S. Patent No. 5,222,234 to Wang et al. (hereinafter "*Wang*"). Applicant respectfully traverses the rejections and request reconsideration based on the following remarks.

III. Amendments to the Claims

In this Amendment and Response to the Office Action, Applicant amends claims 1, 9-14, 17, 25-30, 33, 40, and 42. Further, Applicant cancels claims 3, 19, and 35 and incorporates the elements claimed therein into claims 1, 17, and 33, respectively. Support for amendments to claims 1, 17, and 33 can be found, at least, in the Specification at page 8, lines 1-5; page 10, line 25 -page 11, line 2; and page 12, lines 7-10.

Applicant respectfully requests that this Amendment and Response be entered by the Examiner, placing the claims in condition for allowance. This Amendment and Response should allow for immediate action by the Examiner.

Further, Applicant submits that the entry of the Amendment and Response would place the application in better form for appeal, should the Examiner dispute the patentability of the pending claims.

¹ The Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicant declines to automatically subscribe to any statement or characterization in the Office Action.

IV. Response to Rejections

Applicant respectfully traverses the above identified rejection of claims under 35 U.S.C. §103(a) because a *prima facie* case of obviousness has not been established. As discussed in detail below, the scope and content of *Kayahara* and *Wang* have not been properly determined, nor have the differences between the claimed invention and the cited references been properly ascertained. Accordingly, a reason why the prior art would have rendered the claimed invention obvious to one of ordinary skill in the art has not been clearly articulated.

A. Standard for the Rejection of Claims under 35 U.S.C. § 103(a)

"The key to supporting any rejection under 35 U.S.C. §103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. . . . [R]ejections on obviousness cannot be sustained with mere conclusory statements." M.P.E.P. §2142, 8th Ed., Rev. 6 (Sept. 2007) (internal citation and inner quotation omitted). "In determining the differences between the prior art and the claims, the question under 35 U.S.C. §103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious. M.P.E.P. §2141.02(I) (emphases in original).

"[T]he framework for objective analysis for determining obviousness under 35 U.S.C. §103 is stated in *Graham v. John Deere Co.*, 383 U.S. 1, 148 U.S.P.Q 459 (1966). . . . The factual inquiries . . . [include determining the scope and content of the prior art and] . . . [a]scertaining the differences between the claimed invention and the prior art." M.P.E.P. §2141(II). "Office personnel must explain why the difference(s)

between the prior art and the claimed invention would have been obvious to one of ordinary skill in the art." M.P.E.P. §2141(III).

The Supreme Court in *KSR Int'l Co. v. Teleflex Inc.*, 82 U.S.P.Q.2d 1385 (U.S. 2007) held that "[t]here is no necessary inconsistency between the idea underlying the TSM [teaching, suggestion, motivation] test and the *Graham* analysis." M.P.E.P. §2141 (rev. 6, Sept. 2007), citing *KSR* at 82 U.S.P.Q. 2d at 1396. Applicant understands this to mean that when applicable, as here, TSM reasoning may still be applied not only by an examiner but also by Applicant to refute a 35 U.S.C. §103 rejection.

B. As the Examiner Expressly Acknowledged, *Kayahara* Does Not Teach or Suggest Elements of Claim 1.

In particular, *Kayahara* does not teach or suggest:

"accepting input, from a user via a graphical user interface,
the input comprising a **selection of at least one resource** from the
at least one search result, . . .

preserving the selected at least one resource in a **computer
system location that is different from the data collection**, . . .

the computer system location compris[ing] a **selected preserved
content folder** created based on input from the user . . ."

as recited in amended claim 1. (Emphasis added.)

The Office Action confirms that *Kayahara* does not clearly disclose "accepting input, from a user via a graphical user interface, the input comprising a selection of at least one resource from the at least one search result, . . . preserving the selected at least one resource in a computer system compris[ing] a folder" See Office Action at 3.

C. **Wang Does Not Teach or Suggest Elements of Claim 1.**

The Office Action cites to the Abstract of *Wang* as teaching that the “search result document may be stored in another document such as a folder.” See Office Action at 3. But that suggestion is not correct. Nowhere in the Abstract or elsewhere in *Wang* is there a suggestion or teaching of a user selecting a resource from search results to save the selected resource in a computer system location that is different from a data collection and that comprises a selected preserved content folder created based on input from the user.

Wang discloses a system which enables users to search for documents stored in a shared library and to store the results of a search in a list called a “Search Result Document.” See *Wang* at col. 7, lines 52-57. Applicant respectfully points out that *Wang* does not select at least one document from the search results for preservation of the content of the selected document. Therefore, nowhere in *Wang* is there disclosure of “input comprising a selection of at least one resource from the at least one search result, for preserving the selected at least one resource...,” as recited in claim 1.

Moreover, *Wang* does not disclose a graphical user interface for accepting such input from a user. The only input mechanism disclosed by *Wang* is the search command itself. There is no teaching of “accepting input from a user via a graphical user interface...” Therefore, *Wang* does not explicitly teach the recited element of claim 1.

In addition, the Office Action analogizes the *Wang* “Search Result Document,” as disclosed in the *Wang* Abstract and illustrated in *Wang* FIG. 15, to the recited “selected content.” See Office Action at 3. This is an incorrect analogy; first, the Search Result

Document is not "selected." Second, the *Wang* "Search Result Document" is a list; it is not "the selected at least one resource from the least one search result, . . . comprising . . . content," as recited in amended claim 1.

Further, the Office Action analogizes the *Wang* "folder," as disclosed in the *Wang* abstract, to Applicant's recited folder. See Office Action at 3. However, *Wang*'s folder is not the "selected preserved content folder," as recited in amended claim 1. *Wang* does not teach or disclose preserving selected content in a folder. Therefore, the *Wang* folder is different from Applicant's selected preserved content folder.

Moreover, the *Wang* folder is located in a shared library, whereas Applicant's selected preserved content folder is located in a "computer system location that is different from the data collection," as recited in amended claim 1. As discussed in the previous Amendment and Responses dated December 1, 2008 and January 12, 2009, the *Wang* shared library and Applicant's computer system location are not analogous. See Amendment and Response dated December 1, 2008 at 17-18; see also Amendment and Response dated January 12, 2009 at 15-16. *Wang*'s shared library is different from Applicant's computer system location for at least two reasons:

- First, while Applicant's recited computer system location stores selected preserved content, the *Wang* shared library does not store the **selected** preserved content. Assuming *arguendo* that the *Wang* shared library stores content, the *Wang* stored content is not **selected preserved** content. (Emphasis added.)
- Second, the *Wang* search query is executed in the shared library in *Wang*. See *Wang* at col. 4, lines 24-25. However, Applicant's recited search query is not executed in the recited computer system location. Instead, Applicant's recited search query is executed in the recited data collection. See Specification at 8.

Therefore, assuming *arguendo* that there is an analogy between *Wang* 's shared library and one of Applicant's recited elements, the *Wang* shared library would be more analogous to the recited data collection and not to the recited computer system location. Even so, *Wang* would not teach or suggest "preserving the selected at least one resource in a computer system location that is different from the data collection" as recited in amended claim 1, because *Wang* does not teach or suggest preserving a "selected at least one resource" in a "computer system location" that is different from the shared library. Therefore, *Wang* does not disclose the recited features of amended claim 1.

In addition, neither *Kayahara* nor *Wang* discloses "using a processor to execute, in response to the user's selection, a command for preserving the content of the selected at least one resource in the computer system location and adding the preserved content to a second computer system location." In the interview, Applicant's representatives proposed amending claim 1 with such an element, recited in further detail in claims 9 and 12. Although no agreement was reached on the claims' language, Applicant respectfully submits that neither *Kayahara* nor *Wang* disclose adding the preserved content to a second location.

D. The Office Action Does Not Establish a *Prima Facie* Case that Independent Claim 1 is Obvious in View of *Kayahara* and *Wang*.

Although no Office Action has suggested that *Kayahara* teaches or suggests the above-quoted elements recited in amended claim 1, the Office Action erroneously suggests that *Wang* cures the deficiency in those references. As explained above,

however, *Wang* does not teach the above-quoted elements recited in amended claim 1.

In short, neither *Kayahara* nor *Wang* teach or suggest,

“accepting input, from a user via a graphical user interface,
the input comprising a **selection of at least one resource** from the
at least one search result, . . .

preserving the selected at least one resource in a **computer
system location that is different from the data collection**, . . .
the computer system location compris[ing] a **selected preserved
content folder** created based on input from the user . . .

“using a processor to execute, in response to the user’s selection, a
command for preserving the content of the selected at least one
resource in the computer system location and **adding the
preserved content to a second computer system location**,”

as recited in amended of claim 1.

Thus, the Office Action failed to properly set forth the scope and content of *Wang*, and to delineate the differences between claim 1 and the cited references. Without the proper framework for assessing obviousness under 35 U.S.C. § 103, the Office Action fails to clearly articulate any reason why claim 1, as a whole, would have been obvious in view of *Kayahara* and *Wang*.

The Patent Office has the burden to provide some tenable rationale as to *why* and *how* one of ordinary skill in the art would combine *Kayahara* and *Wang* so as to arrive at the combination recited in claim 1. In the Office Action, no such tenable rationale is provided. The assertions in the Office Action cited as rationale for the obviousness of modifying *Kayahara* by the teachings of *Wang* are essentially conclusory statements that the identified modifications could be performed. And

ultimately, even if *Kayahara* were modified as the Office Action proposes, the resultant method would not feature the above quoted elements of amended claim 1.

With respect to the rejection of claim 1, the Office Action asserts, "It would have been obvious to one of ordinary skill in the art... to modify *Kayahara*... for the purpose of saving search results...." See Office Action at 3-4. In addition, for claims 46, 49, and 52, the Office Action asserts, "The normally skilled artisan would... for the purpose of making information available to a visitor at a website." See Office Action at 5.

At best, the Office Action's assertions could be considered assertions that the proposed modifications could be performed. However, "[t]he mere fact that a reference can be combined or modified does not render the resultant combination [or modification] obvious unless the results would have been predictable to one of ordinary skill in the art." M.P.E.P. §2143.01 (emphasis in original). Combining *Kayahara* and *Wang* would not result in a predictable variation of Applicant's invention because a hypothetical *Kayahara* and *Wang* combination, which, as noted above, would lack recited elements, would not result in the elements recited in claims 1, 17, and 33 of the present application. Because it would lack a recited element of Applicant's invention, it would not be a predictable variation of Applicant's invention.

Moreover, assuming *arguendo* that the recited features are disclosed in *Wang*, the *Kayahara* and *Wang* references can not be combined because *Kayahara* specifically teaches away from conventional searching operations as disclosed in *Wang*, "Accordingly, the conventional information searching method cannot easily extract information which the user desires," (*Kayahara* at col. 1, lines 50-52) and "the searching operation is simple compared to the searching which is performed conventionally by

only using a keyword" (*Kayahara* at col. 12, lines 33-38). Therefore, one of ordinary skill in the art would not know to combine these two references.

For at least these reasons, a *prima facie* case of obviousness with respect to claims 1, 17, and 33 has not been established and, therefore, the rejections of claims 1, 17, and 33 under 35 U.S.C. §103 as being obvious over *Kayahara* in view of *Wang* are improper and should be withdrawn.

For at least the reasons stated above with respect to claims 1, 17, and 33, the rejection of the claims, which include all the limitations of the independent claims from which they depend directly or indirectly, is also improper and should be withdrawn.

E. The Office Action Does Not Establish a *Prima Facie* Case that Dependent Claims Are Obvious over *Kayahara* in View of *Wang*.

Claims 5 and 7-16 depend from claim 1; claims 21 and 23-32 depend from claim 17; claims 37 and 39-60 depend from claim 33; and each include all of the limitations of claim 1, 17, or 33. For at least the reasons noted above that the Office Action fails to establish a *prima facie* case that claims 1, 17, or 33 are obvious in view of the cited references, the Office Action fails to establish a *prima facie* case that any of claims 5, 7-16, 21, 23-32, 37, and 39-60 is obvious over *Kayahara* in view of *Wang*. Therefore the 35 U.S.C. §103(a) rejection of claims 5, 7-16, 21, 23-32, 37, and 39-60 is improper, and should be withdrawn.

V. Conclusion

For all of the reasons cited in this response and previous responses, which are hereby incorporated by reference, Applicant submits that this claimed invention, as amended, is not obvious in view of the prior art references cited against this application.

Applicant therefore respectfully requests that this Amendment and Response be entered by the Examiner, placing the claims in condition for allowance. This Amendment and Response should allow for immediate action by the Examiner.

Further, Applicant submits that the entry of the Amendment and Response would place the application in better form for appeal, should the Examiner dispute the patentability of the pending claims.

In view of the foregoing amendments and remarks, Applicant respectfully requests reconsideration of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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Dated: May 8, 2009

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